

REMARKS

Status of the Application

In the Advisory Action dated November 23, 2004, the Examiner refuses to enter the Reply after Final under 37 C.F.R. § 1.116 filed on November 12, 2004 because the claim amendments presented therein allegedly raise new issues that require further consideration and/or search, and are not deemed to place the application in better form for appeal. Thus, for purposes of Appeal, claims 1 and 6 are allowed, while claims 2 and 7-12 remain rejected.

Applicants filed a Supplemental Reply after Final under 37 C.F.R. § 1.116 on January 11, 2005 requesting entry of both the Reply after Final and the Supplemental Reply after Final. However, the USPTO issued an Advisory Action Before the Filing of an Appeal Brief and a Notice of Non-Compliant Amendment (37 C.F.R. § 1.121) on March 1, 2005 stating that neither the Reply after Final nor the Supplemental Reply after Final were entered into the record of the present application. As such, the claims of record correspond to the Listing of Claims presented in the Reply under 37 C.F.R. 1.111 filed on December 8, 2003.

In order to obtain entry of the Reply after Final, Applicants submit herewith a Request for Continued Examination under 37 C.F.R. § 1.114. **The RCE requests entry of the Reply after Final filed on**

November 12, 2004 and the instant Preliminary Amendment. In this Preliminary Amendment, claims 2 and 11 are canceled, and claims 7 and 8 are amended to depend from allowed claims 1 and 6. No new matter is inserted into the application.

In summary, claims 1, 6-10, and 12 will be pending and in condition for allowance upon entry of the Reply after Final filed on November 12, 2004 and the instant Preliminary Amendment.

Allowability of the Present Application

As of November 23, 2004 (the date of issuance of the Advisory Action), two issues remain in the present application precluding allowance of the claims. Applicants will now address each issue in turn.

First, claims 2 and 7-9 stand rejected under 35 U.S.C. § 112, first paragraph for allegedly containing subject matter neither described in, nor enabled by, the specification. Claim 2 is canceled herein, thus rendering rejection thereof moot. Claims 7-9 are amended herein to no longer depend from claim 2. Thus, the instant rejection is overcome.

Second, in the Advisory Action dated November 23, 2004, the Examiner states that the proposed amendment to claim 8 in the Reply after Final raises new issues under 35 U.S.C. § 112, second paragraph. Specifically, the Examiner writes:

Claim 8 [is] amended to recite that the nucleic acid promotes expression and that expression is promoted by said promoter raises new 112 2nd issues in lieu of claim 11 which recites that another promoter controls expression.

Claim 11 is canceled herein. Applicants note that in claim 8, the inventive nucleic acid is inserted upstream from the polynucleotide encoding the protein of interest. Applicants respectfully submit that the cancellation of claim 11 herein precludes any new issues under 35 U.S.C. § 112, second paragraph. Therefore, no new issues exist which would require further consideration and/or search by the Examiner.

In summary, Applicants respectfully submit that the cancellation of claims 2 and 11 herein overcomes all outstanding rejections so that the present application is in condition for allowance. The Examiner is respectfully requested to issue a Notice of Allowance indicating that claims 1, 6-10, and 12 are allowed.

Request for Interview

As discussed with the Examiner via telephone on March 7, 2005, entry of the Reply after Final and Preliminary Amendment should place the present application into condition for allowance. Nevertheless, should there be any outstanding matters that need to

be resolved in the present application, the Examiner is respectfully requested to contact Kristi L. Rupert, Ph.D. (Reg. No. 45,702) at the telephone number of the undersigned below. Given the lengthy pendency of the present application, the Examiner is respectfully requested to contact Applicants' representative prior to the issuance of any further Office communication(s).

Conclusion

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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